

### **REMARKS**

Reconsideration of the application in light of the amendments and the following remarks is respectfully requested.

#### **Status of the Claims**

Claims 1, 10 and 18 have been amended. No new matter is added.

Claims 37 and 38 are cancelled.

Claims 1-36 are currently pending.

#### **Restriction of the Claims**

Claims 37 and 38 stand withdrawn as being directed to a non-elected invention. The Examiner states that muscle tissue is different than neural tissue and contends that a method and apparatus for sensing activity of muscle tissue would require a separate search in the art. Claims 37 and 38 have been cancelled rendering the restriction moot.

#### **Allowable Subject Matter**

Applicants would like to thank the Examiner for the indication that claims 5, 27, 29 and 31 contain allowable subject matter. The Examiner states that these claims are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

#### **Rejections of the Claims**

Claims 1, 2, 10, 26 and 28 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,515,848 to Corbett, III et al. ("Corbett '848") in view of U.S. Patent No. 5,201,903 to Corbett, III et al. ("Corbett '903").



Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Schulman in view of Corbett '848, and further in view of Lieber and further in view of Imram.

Claims 32-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Corbett '848 and further in view of U.S. Patent No. 6,374,140 to Rise.

Applicant has amended independent claims 1 and 18 to recite a method including the step of placing an electrode that is smaller than 10  $\mu\text{m}$  into a blood vessel proximate to neural tissue. Claim 10 has been amended to recite a device including an electrode that is smaller than 10  $\mu\text{m}$ . The small size allows the electrode to be inserted into capillaries. As discussed with the Examiner during the October 10, 2005 interview, none of the cited references disclose or suggest an apparatus or method including an electrode that is small enough to be inserted into capillaries, i.e. smaller than 10  $\mu\text{m}$ . Thus, claims 1, 10 and 18 are patentable over the cited references.

Claims 2-9, 26, 27 and 32-36 depend from claim 1. Claims 11-17, 28 and 29 depend from claim 10. Claims 19-25, 30 and 31 depend from claim 18. Claims 2-9, 11-17 and 19-36 are patentable for at least the same reasons as their respective base claims.

### CONCLUSION

Each and every point raised in the Office Action dated August 1, 2005 has been addressed on the basis of the above remarks. In view of the foregoing it is believed that claims 1-36 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue. A prompt and favorable action in that regard is earnestly solicited.

Respectfully submitted,

By Pierre R. Yanney  
Pierre R. Yanney

{W:\05986\100k521us1\00563856.DOC 1 2 3 4 5 6 7 8 9 10 11 12 13 14 15 16 17 18 19 20 21 22 23 24 25 26 27 28 29 30 }